

Reply to Final Office Action dated March 4, 2009

Response dated June 4, 2009

REMARKS/ARGUMENTS

Claims 20, 24, 35, 37, 50, 51 and 53-55 are pending in this application. Claim 20 has been amended for a minor informality, i.e., to depend from claim 37. No new matter has been added.

Reconsideration of the application is requested in view of the following remarks.

Rejection under 35 U.S.C. § 112, 2nd paragraph

The rejection of claims 20, 24, 35, 50 and 51 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is respectfully traversed. Applicants point out that claim 35 has been amended to depend from claim 37, as indicated above.

Regarding the percentages recited in claims 20, 24, 35, 50 and 51, Applicants point out, as previously argued, the term “percentage” or “%” is a quantitative measurement that generally refers to the *amount* of nanoparticles in the film. These specific amounts, as understood by one having ordinary skill in the art, can be based on the mass (by weight), since they refer to the amount of nanoparticles in the film. Therefore, the rejections should be withdrawn.

Rejection under 35 U.S.C. § 102

The rejection of claim 53 under 35 U.S.C. § 102(b) as anticipated by Chivukula (US Patent No. 6,066,581) is respectfully traversed for reasons of record and the additional reasons below.

According to the Office, The PTO does not consider (or weigh) the recited process limitations of a product-by-process claim during examination, citing *In re Thorpe*, 777 F.2d 695, 698 (Fed.Cir. 1985) and other past case law. However, Applicant points out that the Federal Circuit has overruled past legal precedent concerning product by process claims. In particular, in *Abbott Laboratories v. Sandoz Inc.*, __ F.3d __ (Fed. Cir. 2009)(Rader, J.)(partially *en banc*)(citations omitted), the court overruled *Scripps Clinic & Research Foundation v. Genentech, Inc.* 927 F.2d 1565 (Fed. Cir. 1991)(Newman, J.), the court held that held that for purposes of determination of infringement, a product-by-process claim is infringed only when

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the same product defined by the claims is also made by the process set forth in the claims that is used to define the product.

Quoting *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 19 (1997), the majority of the court noted that “the Supreme Court has reiterated the broad principle that “[e]ach element contained in a patent claim is deemed material to defining the scope of the patented invention.”” The majority, noting that “*Warner-Jenkinson* … reinforces the basic rule that the process terms limit product-by-process claims” concluded that “[t]o the extent that *Scripps Clinic* is inconsistent with this rule, this court hereby expressly overrules *Scripps Clinic*.”

In light of this recent legal precedent, Applicant requests that all of the limitations of claim 53 be considered, as previously argued, in which there is no indication or description of a dielectric thin film with a relative dielectric constant greater than 10 *consisting essentially of* the components of claim 37 (from which claim 53 depends).

Accordingly, Applicant requests that the rejection be withdrawn.

Rejections under 35 U.S.C. § 103

The rejection of claims 20, 24, 35, 37, 50, 51, 53-55 are rejected under 35 U.S.C. § 103(a) as obvious over Leung (US 2002/0137260) in view of Matijevic (US Patent No. 5,900,223); and the rejection of claim 54 as obvious over Leung in view of Matijevic and further in view of Yokouchi (US Patent No. 5,143,637) are traversed for reasons of record and the reasons discussed below.

In particular, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that “the examiner bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden coming forward with evidence or argument shift to the applicant.” *See Ex parte Martin Haubner and Rolf Pinkos*, Appeal 2009-0449, citing *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993)(overturning a final rejection by an examiner, in which the examiner failed to show that the combination of prior art suggested the claimed process). The Board has also emphasized that the Office must make “a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art.” *See In re Ward and Murphy*, Appeal 2007-3733, citing *In re*

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Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). Moreover, as the Supreme Court stated, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

In present case, Applicants point out that the Office has not shown, other than improper hindsight of the present specification, that the cited references of record describe *all* of the limitations of the claimed process.

The has Office repeatedly recited several statements of "criticality" in the Office Actions regarding certain features/components of the claimed invention. However, Applicants point out that not only are there numerous advantages of all features/components pointed throughout the present specification, but the Office's requirement contravenes the most recent legal precedent established by the Board, i.e., the Office has not met its burden of establishing obviousness.

Therefore, the present are clearly not obvious in view of the above-cited references, alone or in combination. Accordingly, withdrawal of the rejection is requested.

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

The Office is authorized to charge any necessary fees to Deposit Account No. 50-0510.

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Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0510, under Order No. 20140-00343-US2 from which the undersigned is authorized to draw.

Dated: June 4, 2009

Respectfully submitted,

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